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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Christian L. Struble

Confirmation No.: 4820

Application No.: 09/894,213

Examiner: Alvarez, Raquel

Filing Date: 6-27-01

Group Art Unit: 3622

Title: System and Method for Controlling the Presentation of Advertisements

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on May 5, 2005. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Typed Name: Mary Meegan

Signature: Mary Meegan

Respectfully submitted,

Christian L. Struble

By David R. Risley

David R. Risley, Esq.

Attorney/Agent for Applicant(s)

Reg. No. 39,345

Date: 6-6-05

Telephone No.: (770) 933-9500



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Christian L. Struble

Group Art Unit: 3622

Serial No.: 09/894,213

Examiner: Alvarez, Raquel

Filed: June 27, 2001

Docket No. 10010610-1

For: **System and Method for Controlling the Presentation of Advertisements**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Office Action mailed May 5, 2005 has been carefully considered. In response thereto, please enter the following amendments and consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in his Examiner's Answer various responses to Applicant's arguments contained in Applicant's Appeal Brief. Applicant addresses some of those responses in the following.

I. Related Appeals and Interferences

As a first matter, the Examiner states that Applicant's brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the present Appeal. This is not the case. On page 2 of Applicant's Appeal Brief, Applicant states the following under the heading "Related Appeals and Interferences": "There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal."

II. Thibadeau's Lack of Teaching as to Advertisements

Applicant acknowledges the Examiner's admission that Thibadeau is silent as to presenting advertisements.

III. Modification of the Thibadeau System in view of the Helferich Reference

The Examiner maintains his argument that it would have been obvious to modify the Thibadeau system to filter advertisements based upon local weather conditions in view of Helferich's teachings. In expressing this position, the Examiner states:

Applicant argues that Thibadeau doesn't teach filtering advertisement based upon weather. The Examiner wants to point out that Thibadeau teaches filtering weather related information and messages based upon the measured weather information of a particular location.

Applicant agrees that Thibadeau teaches filtering weather related information and messages based upon the measured weather information of a particular location. However, the Examiner still fails to grasp that this fact is the primary problem with the combination of the Thibadeau and Helferich references in rejecting Applicant's claims.

In the various Office Actions received during prosecution of the present application, the Examiner states that it would have been obvious to "replace" the emergency warnings information of Thibadeau with advertisements of Helferich. Even assuming this were true, this would still not render Applicant's claims obvious. Specifically, such "replacement" would only result a system in which advertisements are filtered *based upon the geographic location of the user's set-top box*. Such a "replacement" would still fail to teach or suggest a system or method that filters advertisements *based upon the user's local weather conditions*.

It appears that the Examiner's confusion stems from the fact that Thibadeau filters information based upon weather conditions. However, this teaching is the *opposite* of what Applicant is claiming. Specifically, Applicant claims filtering advertisements based upon weather information, *not* filtering weather information based upon geography. In the first case, the determined information is the weather information. In the latter case, the weather information is the *transmission* that results from a determination as to the user's geographic location.

In view of the above, it is clear that there simply is no motivation in the prior art to modify the Thibadeau system to filter advertisements based upon local weather. First, as has been admitted by the Examiner, Thibadeau does not contemplate filtering advertisements. Second, Thibadeau does not contemplate using weather information as an input to the filtering process. Thibadeau's mere mention of "emergency weather conditions" does not provide a teaching of modifying Thibadeau's system to filter information based upon local weather conditions.

Applicant notes that Helferich does teach measuring a local temperature with a user device (e.g., mobile phone). This teaching is not enough, however, to overcome Thibadeau's disclosure as to filtering based upon geographic location. As was identified in the Appeal Brief and Office Action responses prior to submission of the Brief, Thibadeau's entire disclosure is devoted to the problem of determining the user's geographic location. In fact, substantially the entire Detailed Description describes a system that is intended to determine geographic location (e.g., latitude and longitude coordinates) and using that information to filter information that will be transmitted to a user's set top box. To simply discard this functionality would be to ignore the primary purpose of the system that Thibadeau described in such great detail. Clearly, a person having ordinary skill in the art would not be motivated to do this given that the "replacement" would render nearly all of Thibadeau's system unnecessary.

As was stated in the Appeal Brief, it is clear that the only motivation to make this "replacement" comes from Applicant's own disclosure. Although Applicant understands that some measure of backward looking is required to formulate an obviousness rejection, the law still requires that there is a teaching or suggestion contained in the prior art to make a rejection under a combination of references. The

references contain no such teaching or suggestion. Indeed, if anything, Thibadeau's strong teachings regarding determination of geographic location would suggest *against* the Examiner's combination.

Even assuming the prior art contained some motivation or suggestion to combine the teachings of Thibadeau and Helferich, that combination would still not result in Applicant's claimed inventions. This is true because Helferich teaches measuring a local temperature *with the same device that receives the information*. Therefore, Helferich's teaching would not render obvious receiving local weather condition information from a sensing unit *that is separate from the computing device*, as is recited in Applicant's claims.

IV. A Display Unit Mounted to a Fuel Pump

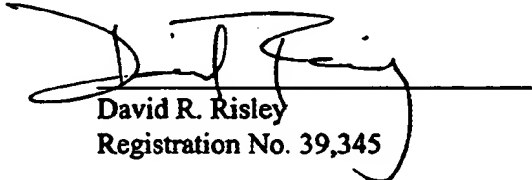
As a final matter, the Examiner reiterates his position that it would have been obvious to present advertising information based upon local weather conditions on a fuel pump display because fuel pump displays are known. Again, Applicant does not dispute that fuel pump displays are known. The problem, however, is an argument that Thibadeau and Helferich, when combined, render presenting advertising information based upon local weather conditions on a fuel pump display obvious. Clearly, the Examiner is considering Applicant's claim limitations in a piecemeal fashion. Specically, the Examiner provides no reason why it would have been obvious from Thibadeau's teaching of presenting weather information to set top boxes and Helferich's teaching of presenting advertisements to a mobile phone to control advertisements that are sent to a fuel pump display based upon local weather conditions. Neither Thibadeau nor Helferich say anything about fuel pump displays. Moreover, a person having ordinary skill in the art would see no reason to apply either

reference's teachings to such fuel pump displays. Again, this is a problem of hindsight. There simply is no support in the prior art for controlling advertisements presented in a fuel pump display based upon local weather conditions. The only motivation for such a solution comes from Applicant's own disclosure.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



David R. Risley
Registration No. 39,345

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

6-6-05

Mary M. Legan
Signature